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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/824,396

04/15/2004

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EXAMINER

BERNATZ, KEVIN M

ART UNIT

PAPER NUMBER

1794

MAIL DATE

DELIVERY MODE

11/19/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Advisory Action Before the Filing of an Appeal Brief	Application No. 10/824,396	Applicant(s) EDELSTEIN ET AL.	
	Examiner Kevin M. Bernatz	Art Unit 1794	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 08 November 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:
- a) ☒ The period for reply expires 6 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☒ The Notice of Appeal was filed on 08 November 2007. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
- (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ They raise the issue of new matter (see NOTE below);
- (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.
- NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL -324).

5. ☐ Applicant's reply has overcome the following rejection(s): _____.

6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: _____.

Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).

9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).

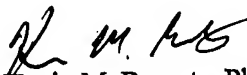
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.

12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____

13. ☐ Other: _____.


 Kevin M. Bernatz, PhD
 Primary Examiner

Continuation of 11. does NOT place the application in condition for allowance because: Applicants' arguments have been considered but are not deemed persuasive.

With regard to the argument directed to the restriction by original presentation of claims 35 - 41, Applicants argue that there is no undue burden on the Examiner due to the similarity of the claimed subject matter and that examination "would involve substantially the same prior art search" (page 2 of response). The Examiner respectfully disagrees.

This is not found persuasive since the Examiner reminds Applicant(s) that a separate classification is a prima facie showing of a serious burden (see MPEP § 803). In addition, while the search may be overlapping, there is no reason to believe the search would be coextensive. As evidence of this, the Examiner notes that Baglin et al. would not be deemed to read on a debit card, since Baglin et al. is directed to a magnetic recording medium which is substantially different in structure than a debit card. As such, Applicants' arguments are not found persuasive and the restriction requirement is made FINAL.

With regard to Applicants arguments that "significantly" is sufficiently defined by the specification (pages 2 - 3 of response), the Examiner notes that the Paragraphs pointed to by Applicants never explicitly recite what magnitude constitutes "significantly lower". Applicants argument that the low permeability is "a value at or close to zero" is not found persuasive since the examiner notes that the specification is not the measure of the invention. Therefore, limitations contained therein can not be read into the claims for the purpose of avoiding prior art. In re Sporck, 55 CCPA 743, 386 F.2d 924, 155 USPQ 687 (1968).

In addition, Applicants argue the differences between the disclosed invention and the teachings of Baglin et al., specifically with regard to the preamble limitation "operable to be non-erasable when exposed to a magnetic field" (pages 3 - 4 of response). The Examiner respectfully disagrees with Applicants' arguments.

Specifically, the Examiner notes that Applicants' arguments fail for at least three reasons. First, the Examiner notes that the limitation is a pre-ambulatory limitation and is not specifically directed to the claimed discrete information storage portions.

Second, the claimed limitation does not recite a magnitude of the magnetic field to which the medium must be "operable to be non-erasable". The Examiner notes that the magnetic recording medium of Baglin et al. is clearly operable to be non-erasable when exposed to certain magnitudes of external magnetic fields (e.g. anything less than the field strength required to write/erase the data). As such, the disclosed information storage medium is "operable to be non-erasable when exposed to a magnetic field", albeit a magnetic field of a magnitude less than the field required to write/erase the data.

Third, the Examiner notes that the actual physical locations of the irradiated "dots" in the Baglin et al. invention can represent non-erasable data (e.g. servo-tracking, etc) (see Baglin et al., Figures 3 and 4, which clearly illustrates that the pattern conveys recorded information - in terms of observed in-plane coercivity, etc). Since such data is due to the physical difference in the material and not simply the direction of the magnetic field, the physical structure of Baglin et al. does represent an information storage medium that is non-erasable when exposed to a magnetic field of any magnitude.

Finally, Applicants argue that the structure of Baglin et al. differs from the structure of Applicants' invention (page 4 of response, first full paragraph). The Examiner respectfully disagrees.

The Examiner notes that, regardless of whether the "bilayer" is formed by intermixing or by ion irradiation, the final physical structure of the claimed invention is one of magnetic material domains adjacent to non-magnetic material domains, wherein the two domains have different permeabilities. Baglin et al. disclose such a structure - magnetic domains surrounded by non-magnetic domains, wherein the magnetic and non-magnetic domains have different magnetic properties, including coercivity, permeability, saturation magnetization, etc (e.g. Figures 3 and 4). As such, the Examiner deems that the rejections predicated on Baglin et al. are proper and the finality of the office action mailed May 8, 2007 is maintained.